

Application. No. 10/668,805  
Amendment dated October 31, 2006  
Reply to Office Action of August 1, 2006

**REMARKS/ARGUMENTS**

Applicant first wishes to thank Examiner Stokes for her continued indication of allowable subject matter. Reconsideration of the above-identified application is respectfully requested in view of the foregoing amendments and the following remarks. Claims 1 and 15 have been amended. Claims 1 - 29 remain in the case.

The claims of the present invention are drawn to a single, one-piece, multifunctional, surgical, rotary instrument to be used in a surgical dental motor driven handpiece for preparing an osteotomy for implant insertion. Applicant's novel tool combines the functions of six individual known surgical instruments into one rotary tool. The inventive device has structural features rigidly affixed to one another forming a unitary device that provides the functions of a crestal bone height reducer, an osteotomy locator, an osteotomy lateral redirector, an osteotomy drill, a tapered countersink, and an osteocompressor. These structural features include a dual-lobed, single plane tip that remains where the drilling is initiated without wandering, thereby facilitating maintaining a precise location for the osseous implant site. Unlike some multifunction dental tools of the prior art, there are no moving or interchangeable parts in Applicant's novel tool; all functions associated with each of the aforementioned structural features are accomplished without adding to, deleting from, or moving any portion thereof.

Claims 1 - 2 and 4 - 28 were rejected under 35 U.S.C. §103(a) as being unpatentable over United States Patent No. 6,364,662, for DIAMOND-LIKE CARBON COATED DENTAL INSTRUMENT, issued April 2, 2002 to Ajay Kumar in view of United States Patent No. 5,139,098 for COMBINED DRILL AND UNDERREAMER TOOL, issued August 18, 1992 to John Blake. While some aspects and/or features of the separate tool bits described in KUMAR

Application. No. 10/668,805  
Amendment dated October 31, 2006  
Reply to Office Action of August 1, 2006

are similar to aspects of the single, one-piece, multifunctional device described and claimed by Applicant, there is no suggestion to combine the features described by KUMAR into Applicant's single, one-piece instrument. Applicant's previous amendment filed May 5, 2006 overcame the Examiner's previous rejection of claims 1 - 2 and 4 - 28 under 35 U.S.C. §102(b) as being anticipated by KUMAR. In his previous response thereto, Applicant amended claims 1 and 15 to recite a single tool including the disclosed structural features. However, the Examiner has now issued a rejection of the same claims under 35 U.S.C. §103(a) as being obvious over KUMAR in view of BLAKE.

BLAKE teaches a dual-purpose dental tool wherein an drill portion has a hollow central portion within which a selectively deployable underreaming apparatus is disposed. Upon actuation, the underreaming apparatus is released from the central portion and is allowed to expand outwardly therefrom to accomplish its intended purpose. A fluid stream is effectively blocked and unblocked to activate and deactivate the underreamer. The Examiner has combined BLAKE with KUMAR to attempt to obviate Applicant's single, one-piece, multi-function osteotome. BLAKE neither teaches nor suggests the various structural elements described and claimed by Applicant. Neither does BLAKE teach or suggest a multi-function tool having NO moving parts (i.e., a one-piece device) as taught and now claimed by Applicant.

Neither do either KUMAR or BLAKE, individually, or in combination, teach or suggest Applicant's dual lobed single plane, lateral osteotomy locator tip. Rather, KUMAR teaches a multi-lobed, multi-planar distal tip known to wander when using a handheld instrument, therefore making maintenance of the precise location of the osseous implant site difficult. BLAKE is silent regarding an osteotomy locator tip.

Application. No. 10/668,805  
Amendment dated October 31, 2006  
Reply to Office Action of August 1, 2006

Case law teaches that if the function of one of the references must be modified so as to render the original function of the claimed apparatus inoperative, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) Also, if the proposed modification or combination would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)

Certainly removing or fixing the movable components of the BLAKE apparatus to form a solid, one-piece device such as that taught and claimed by Applicant, would render the BLAKE underreamer inoperable. Portions of the BLAKE movable underreamer MUST move outwardly from within the confines of the hollow central region of the drill to perform its intended underreaming function.

Applicant has amended claims 1 and 15 to recite a single, one-piece, multi-function rotary tool bit. The amendment is believed to overcome the rejection of claims 1, 2 and 4 - 28 under 35 U.S.C. §103(a) as being unpatentable over KUMAR in view of BLAKE.

Claims 3 and 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over KUMAR. Claims 3 and 17 merely recite an additional limitation to now allowable base claims. Consequently, the amendment of claims 1 and 15 has also overcome the rejection of claims 3 and 17.

Claim 29 was previously indicated allowable.

Application. No. 10/668,805

Amendment dated October 31, 2006

Reply to Office Action of August 1, 2006

In view of the foregoing amendments and remarks,  
Applicant respectfully requests that claims 1 - 29 be allowed  
and the application passed to issue.

I hereby certify that this correspondence is  
being deposited with the United States Postal  
Service as first class mail in an envelope  
addressed to:

Mail Stop \_\_\_\_\_  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

On 10/31/06  
(Date of Deposit)

Cortney Farber 10/31/06  
Cortney Farber (Date)

Respectfully submitted,  
MARK LEVY & ASSOCIATES, PLLC

By: [Signature]  
Mark Levy  
Registration No. 29188  
Attorney for Applicant  
Press Building - Suite 902  
19 Chenango Street  
Binghamton, New York 13901  
Phone: (607) 722-6600